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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/658,175	09/09/2003	Ching-Jer Chang	3220-73417	3175

23643 7590 04/23/2004

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EXAMINER

HABTE, KAHSAI

ART UNIT	PAPER NUMBER
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1624

DATE MAILED: 04/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/658,175	CHANG ET AL.	
	Examiner	Art Unit	
	Kahsay Habte, Ph. D.	1624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-14 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Restriction/Election

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-2 (in part), 3-5, 6-8 (in part), 9-11 and 12 (in part), drawn to compounds where R_1 or R_2 in formula I are heterocyclic moiety (forming 3 rings), classified in classes 540, 548, 549 and 514, subclass various.
 - II. Claims 1-2 (in part), 6-8 (in part) and 12 (in part), drawn to compounds where R_1 and R_2 in formula I are non-heterocyclic moiety (forming 2 rings), classified in classes 540, 548, 549, and 514, subclass various.
 - III. Claims 13-14, drawn to a method of preparing an intermediate compound and preparing unfused tricyclic compound, classified in classes 540, 548, and 549, subclass various.

The inventions are distinct, each from the other because of the following reasons:

Groups I-II are directed to structurally dissimilar compounds such that the variable core created by the varying definitions of R_1 or R_2 in formula I do not belong to the same recognized class of chemical compounds in the art, and references anticipating one invention, would not render obvious the others. Group I is different from Group II, because one of R_1 or R_2 in Group I is a 5 membered heterocyclic ring (three rings are formed), and is different from Group II. Group II is different from Group I, because both R_1 and R_2 are non-heterocyclic moiety. Group III is different from Groups I and II, since it is drawn to a process of making compounds. Note that the intermediate compound is different than the compounds of Group I. The scope of claim 14 in Group III is also

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broader than the scope of the claims in Groups I, because Group III have three rings in which variables X, Y, or Z can be NR, S, O, or Se. Group I is required to have selenophene ring, while Group III is not. The three rings in Group III can be pyrroles, selenophenes, furans, thiophenes, and combinations thereof. Said feature is not present in Groups I and II. Group II has only two rings and one of the rings (the right hand side) is required to be selenophene, that feature is not present in Group III (claim 14). Thus, separate searches in the literature as well as in the U.S. Patent Classification System would be required. Each group's compounds are made and used independently of each other and could support separate patents. The compounds differ significantly in chemical structures. One skilled in the art would not consider such diverse structure equivalents of each other.

If Group I-III is elected; a tentative election of a single species is required.

Because these inventions are distinct for the reasons given above and have acquired separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

A telephone call was made to Ms. Rebecca Ball on April 13, 2002 to request an oral election to the above restriction requirement, but did not result in an election being made. Note: no preliminary amendment has been received.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

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Conclusion

2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kahsay Habte, Ph. D. whose telephone number is (571) 272-0667. The examiner can normally be reached on M-F (9.00AM- 5:30PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached on (571) 272-0674. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.



Kahsay Habte, Ph. D.
Examiner
Art Unit 1624



Mark L. Berch
Primary Examiner
Art Unit 1624

KH
April 20, 2004